

REMARKS

Applicant's representative thanks the Examiner for the telephonic interview conducted on October 22, 2007, in which arguments set forth below were summarized for the Examiner. It was agreed that the Examiner would study these arguments when presented in written form and render a decision at that time. The Examiner also inquired as to the attorney authorization and was informed that the present attorney can be found listed under the law firm's Customer Number.

The Office Action dated August 3, 2007 has been carefully considered. Claims 1-11 are pending, claim 12 is withdrawn from consideration. Claims 1 and 8 are amended.

Claims 1-11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bohm et al. (US 2003/0008137) (US '137) in view of Tomoaki Watanabe et al (JP2000-226561)(JP'561). Applicants traverse the rejection.

US'137 discloses a self-adhesive article for protection of car paint from scratches during transit from factory to dealership (Para. 0001-0002 and 0043-0044). It is a composite material which is a paint-compatible transit protection film (para. 0003) for automotive *exterior* parts (e.g. bumper and mirror), in contrast to the claimed invention for pre-applied outer layer material for automotive *interior* trim. This difference has important consequences. US'137 deals with an article for protecting the paint from scratching, for use during transit of new vehicles from factory to dealership and, importantly, to be peeled off prior to use by the car owner, leaving no residue and not marring the paint. In contrast, the presently claimed article is for permanent adhesion in forming automotive interior trim during the life of the car. Therefore, the adhesives for the US'137 reference and the presently claimed article have different characteristics. While the present invention recites a hot melt whose ingredients result in secure adhesiveness, the US'137 reference teaches away from securely bonding adhesives as being incompatible with preserving the paint job (Para. 0006).

The Examiner's rejection of claims 1, 4, 7 and 8 rests on the grounds that it would have been obvious to combine the hotmelt adhesive of Tomoaki, which has similarities to the presently claimed invention, in the invention of Bohm. However, this combination would have been inoperable for its intended purpose. The purpose of the Bohm invention is to apply a

removable self-adhesive composite material to the exterior car paint or to rounded surfaces, later being able to remove the composite by peeling it off without damaging the car paint. However, the Tomoaki hotmelt adhesive is not designed to be removable. This is evident since Tomoaki criticizes the problems of prior art adhesives, such as those in which the adhered surface of the hotmelt adhesive *was apt to be peeled off* and Tomoaki aims to provide an improved hotmelt. (JP'561 at page 7, para. 0005). Since the combination of the Tomoaki hotmelt to the Bohm article would make Bohm inoperable for its intended purpose, the combination is not reasonable and does not provide reasonable grounds for the obviousness rejection.

Still further, the purpose of the Bohm invention is to make a *self-adhesive* article (Abstract), thus one that is tacky on its own without needing further operations to become adhesive such as application of heat. However, a hotmelt requires heat to soften and become adhesive. A hotmelt is an adhesive composition that is softened by heat and hardened or set by cooling. Thus the modification of Bohm to contain the Tomoaki hotmelt would make it further inoperable for its intended purpose of being self-adhesive.

Further still, the prior art references relied upon provide no assertion that there is any problem with the Bohm protective article that would motivate a person of ordinary skill in the art to modify it. The grounds for the rejection stated that the motivation for modifying Bohm was the desire to use a hot-melt adhesive that has high flexibility, low possible coating temperature, low coating viscosity, high tack generation temperature, high blocking resistance and short open time (These are the characteristics of the Tomoaki hotmelt at para. 0009 of the JP'561 translation). No explanation was provided as to how these characteristics would make an improved self-adhesive article for mechanical protection of painted plastic mounted parts of automobiles and thus motivate a modification of the Bohm protective article. To the contrary, JP'561 states that the characteristic of any hotmelt adhesive which allows it to be peeled off, is that the flexibility of the hot melt is low (JP'561 at para. 0005). Therefore, it appears unreasonable that one of skill in the art would have been motivated to modify Bohm to use a hotmelt adhesive with high flexibility.

In addition, the Bohm protective article does not meet the claimed limitations. The Examiner stated that with respect to claims 2 and 10, the backing of Bohm is equated to a surface

layer. However, claims 2 and 10 state that the the outer layer material is formed *solely* of a surface layer material with the hotmelt applied directly to the back surface. However, Bohm states that the backing material is a film whose outer side is *laminated with a layer of knitted fabric*. Thus, by virtue of being a film laminated with a layer of knitted fabric, the backing material of Bohm does not fit the limitation requiring the interior trim to be formed *solely* of a surface layer material with the hotmelt applied directly to the back surface of the surface layer material.

The Examiner further stated that regarding claims 3 and 11 Bohm discloses that the film layer may be foamed at para. 0018. However, instant claims 3 and 11 further recite the limitation wherein the hotmelt is applied to the surface of the foam layer. Adhesive applied directly to the foam is not disclosed in Bohm. Bohm discloses that the adhesive is applied to the backing film (Abstract and para. 0014).

The Examiner stated that, regarding claims 3 and 11, Bohm discloses that the knitted fabric can be joined to the film backing using hot-melt adhesive (para. 0031). This is true, however, the hotmelt described in this paragraph is not the same adhesive component as the self-adhesive component that is used to adhere the film to the car paint. The hot-melt referred to in para. 0031 is an adhesive that joins the film backing to the laminated knitted fabric. Bohm describes that in addition to the pressure-sensitive self-adhesive layer applied to the *underside* of the film (para. 0014), the *top of the film* is laminated to a knitted fabric (para. 0013) and that this lamination of the knitted fabric to the top of the backing film can be accomplished using solvent-free laminating adhesives, such as a hotmelt (para. 0031). The Examiner stated that this hotmelt could be modified to use the Tomoaki hotmelt (Office Action at page 5, first paragraph). Even if the Tomoaki hotmelt is substituted for the Bohm hotmelt for laminating, the combination does not meet the limitations of any of the instant claims, since, in the instant claims, the hotmelt is one that is applied to the back surface of the outer layer material and is *exposed* on the back surface of the outer layer material to provide an adhesive surface after being heated, i.e., it is exposed on the pre-applied outer layer material so that it can be adhered to a molded object in forming the automotive interior trim (Claim 12). The hotmelt disclosed by Bohm is one that is

used as a laminating adhesive, and is applied to the top of the film and is between the film and the knit layer. It is not exposed as in the claims.

Regarding claim 5, the Examiner stated that Bohm discloses adhesive with thickness of 25 micrometer. However, this is the adhesive that the Examiner suggests should be substituted by the Tomoaki hotmelt. Therefore it is not reasonable to reject claim 5 on the basis of disclosure of the characteristics of an adhesive that the Examiner proposes should not be used.

In view of the foregoing arguments, Applicants submit that all pending claims are in condition for allowance and request that all claims be allowed.

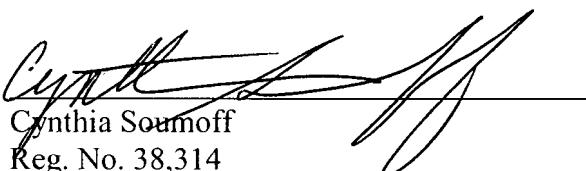
In further explanation of the differences between the present invention and the prior art references, Applicants state the following. The pre-applied outer layer material for automotive interior trim is mainly used at the assembly line for manufacturing parts of the automobile. In one assembly line step, interior automotive trim can be formed by vacuum adhesion. In such a step, the claimed outer layer material is loaded and a mold or an article to be adhered to the outer layer material is pressed there against or suctioned and the two pieces are adhered by contacting each other. Residual stress of the outer layer material is retained and initial adhesiveness and creep specifications come into play. Further, on the assembly line, high speed adhesiveness is required. Therefore, the specific properties of the hotmelt adhesive that is claimed are required.

In contrast, Bohm's paint-compatible transit protection film only requires an adhesive that has applicability to protecting the painted plastic automotive parts. For this reason there is neither description nor suggestion for an adhesive with strong adhesive strength and satisfying appropriate creep specifications. In further contrast, the Tomoaki adhesive does not meet the heat resistant creep specifications of the presently claimed invention.

The Examiner is invited to contact the undersigned should he believe that this would expedite prosecution of this application. It is believed that no fee is required. The Commissioner is authorized to charge any deficiency or credit any overpayment to Deposit Account No. 13-2165.

Respectfully submitted,

Dated: October 29, 2007



Cynthia Soumoff
Reg. No. 38,314
Attorney for Applicant

MATHEWS, SHEPHERD, McKAY & BRUNEAU, P.A.
29 Thanet Road, Suite 201
Princeton, NJ 08540
Tel: 609 924 8555
Fax: 609 924 3036